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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BAO TRAN

Appeal 2009-010177
Application 09/842,599
Technology Center 3600

Decided: June 8, 2010

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Bao Tran (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1 and 16-34, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION[1]

We AFFIRM.

THE INVENTION

The Appellant invented a system and method for trading intellectual property (Specification 1:10-11).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

> 1. A system to support trading of intellectual property (IP), comprising:
>
> [1] a processor;
>
> [2] a user interface displayed by the processor to accept a request to trade an IP asset;

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[1] Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed March 12, 2008) and Reply Brief ("Reply Br.," filed June 29, 2008), and the Examiner's Answer ("Ans.," mailed June 13, 2008), and Final Rejection ("Final Rej.," mailed October 5, 2007).

[3] a user interface displayed by the processor to store information on the IP asset including rating information; and

[4] a database coupled to the user interface and to the processor to store data associated with one or more IP assets, the database supporting the trading of the IP asset.

THE REJECTIONS

The Examiner relies upon the following prior art:

Riordan, Teresa, "Long before that improved mousetrap is officially certified, you can now market it on the Web", *The New York Times*, p.C.6, March 13, 2000.

Claims 1 and 16-34 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1 and 16-34 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention.

Claims 1 and 16-34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Riordan and Official Notice.

ISSUES

The issue of whether the Examiner erred in rejecting claims 1 and 16-34 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement turns on whether the Specification of the claimed invention describes the claimed limitations and conveys to a

person with ordinary skill in the art that the Appellant was in possession of the invention.

The issue of whether the Examiner erred in rejecting claims 1 and 16-34 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention turns on whether a person with ordinary skill in the art would have understood what is being claimed with respect to the terms rating information and predetermined time.

The issue of whether the Examiner erred in rejecting claims 1 and 16-34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Riordan and Official Notice turns on whether Riordan describes the limitations as found by the Examiner and whether the Appellant has traversed the Examiner's taking of official notice.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Appellant's Disclosure

01. A portal provides access to a bid, auction and sale system wherein the computer system establishes a virtual showroom which displays the intellectual property (IPs) offered for sale and certain other information, such as the offeror's minimum opening bid price and bid cycle data which enables the potential purchaser or customer to view the IP asset, view rating information

regarding the IP asset, and place a bid or a number of bids to purchase the IP asset (Specification 12:26-31).

02. The system permits sellers to list assets for sale and buyers to bid on assets of interest and all users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy to use online service that is available 24 hour-a-day, seven days a week (Specification 3:18-21).

03. The techniques support real time and interactive auctions that allow bidders to place bids in real time and compete with other bidders around the world using the Internet (Specification 3:26-28).

04. The techniques allow customer bids to be automatically increased as necessary up to the maximum amount specified, so bids can be raised and auctions won even when bidders are away from their computers (Specification 3:28-30).

05. The portal provides the user with access to a network of IP lawyers for assistance in finalizing applications (Specification 4:2-4). The portal also links the user with IP related businesses such as those who specialize in trading or mediating IP related issues and links the user to non-IP resources, including venture capitalists and analysts who track evolving competition and market places (Specification 4:4-8).

06. The portal remains with the users the entire time they are online and can automatically update the users on any competing products of any new patents or trademarks granted in the areas of interest

(Specification 4:8-10). The constant visibility of the portal allows advertisements to be displayed for a predetermined period of time (Specification 4:14-15).

07. If the IP asset is patentable, but the inventor has not pursued a patent application, the portal prompts the inventor to provide sufficient information to file a provisional patent application (Specification 17:9-11).

08. The Appraise button provides an electronic valuation module to estimate the value of the IP assets (Specification 7:22-23). The Escrow button allows a buyer and seller to have a neutral third party watch over the title transfer process (Specification 8:16-17).

Facts Related to the Prior Art

Riordan

09. Riordan is directed to a website for the swapping and selling of intellectual property (Riordan Abstract).

10. Riordan describes an intellectual property trading website that allows users to post a new invention thereby enabling the trading and purchasing of technology in a swifter, easier, and more precise manner (Riordan 1). The intellectual property includes patents, trade secrets, engineering expertise, regulatory compliance advice, and other services (Riordan 2). Users post marketing information regarding their technology and those interested in purchasing have to purchase additional information regarding the available technology (Riordan 2). The trading

website takes a ten percent of the total deal price as commission (Riordan 2).

ANALYSIS

Claims 1 and 16-34 rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement

The Examiner found that the term "ratings information" in limitation [3] of claim 1 is not supported by the Specification (Ans. 3). The Examiner further found that claims 21-33 are not supported by the Specification (Ans. 3-5). The Appellant contends that Specification page 12 describes the "rating information" limitation in claim 1 (App. Br. 3). The Appellant further contends that claims 21-33 are supported by the Specification on pages 3-4, 6, 8, 12, 13, and 17 (App. Br. 3-4).

We agree with the Appellant. The Specification describes a portal to sell intellectual property, where the users can view the intellectual property, rating information, and place a bid for purchase (FF 01). This description in the Specification clearly illustrates that the Appellant had possession of the feature to show rating information with an intellectual property asset as claimed.

The Examiner fails to provide any further rationale as to why the Specification does not demonstrate that the Appellant was not in possession of the claimed invention. The Specification further describes the limitations recited in claims 21-33 (FF 02-08). Again, the Examiner has failed to set forth any rationale as to why the Specification fails to demonstrate that the Appellant was in possession of the claimed invention. As such, the

Examiner erred in rejecting claims 1 and 16-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1 and 16-34 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention

The Examiner found that the term "rating information" is indefinite and the term "predetermined time" is a measurable unit that is indefinite in scope (Ans. 5). The Appellant contends both of these terms are definite and limit the claims (App. Br. 4-5).

We agree with the Appellant. The test for definiteness is whether "those skilled in the art would understand what is claimed when the claim is read in light of the Specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). Although the terms "rating information" and "predetermined time" are broad in scope, they are not indefinite because a person with ordinary skill in the art would have understood what is being claimed. As illustrated by the Examiner, "rating information" has meanings known in the industry and as such a person having ordinary skill would have understood what is being claimed since this is a familiar term (Ans. 3). A "predetermined time" is a measurable unit, however, a measurable unit is not indefinite in nature. A person with ordinary skill in the art would have understood that it is not an indefinite period of time. As such, we find that the Examiner erred in rejecting claims 1 and 16-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention.

Claims 1 and 16-34 rejected under 35 U.S.C. § 103(a) as unpatentable over Riordan and Official Notice

The Examiner found that Riordan describes all of the limitations of claim 1, except for the limitation to store ratings information (Ans. 5). The Examiner took official notice that the limitation to store rating information is old and well-known in the art (Ans. 5) and found that a person with ordinary skill in the art would have been motivated to modify Riordan to include rating information in order to reduce the time to make intellectual property purchasing decisions and to reduce due diligence expenses (Ans. 5).

The Appellant contends (1) Riordan fails to describe a processor and a database (App. Br. 5). We disagree with the Appellant. Riordan describes a website that sells and trades intellectual property (FF 10). The website displays technology available for purchase (FF 10). A person with ordinary skill in the art would have understood that a website that displays a catalog of intellectual property necessarily uses a database to store intellectual property information and a processor to display the information. The Appellant has failed to provide any further rationale as to how the claimed invention is distinguished from the prior art. As such, we find Riordan describes a processor and a database as required by claim 1.

The Appellant further contends that (2) Riordan fails to describe intellectual property (IP) rating information (App. Br. 6). We disagree with the Appellant. As noted *supra*, the Examiner found that the limitation to

store intellectual property rating information is old and well-known in the art and the Examiner took official notice of this fact (Ans. 5). If an Applicant does not seasonably traverse the taking of official notice during examination, then the object of the official notice is taken to be admitted prior art. *In re Chevenard, 139 F.2d 711, 713 (CCPA 1943).* An adequate traversal must contain adequate information or argument to create on its face, a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. *See In re Boon, 439 F.2d 724, 728 (CCPA 1971).*

The Appellant has failed to seasonably traverse the Examiner's taking of official notice. The Appellant's argument that Riordan fails to describe IP rating information does not cast a reasonable doubt on the Examiner's finding that IP rating information is old and well-known in the art. This argument only speaks to the description of Riordan and fails to provide any rationale as to whether IP rating information is not old and well-known. Therefore, the storing of IP rating information is taken to be admitted prior art.

Furthermore, the Appellant's argument that Riordan fail to describe IP rating information amounts to nothing more than the mere attacking of the Riordan reference separately from the officially noticed facts. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). As such, the Appellant's argument that Riordan fails to describe IP rating information is not found persuasive.

The Appellant also contends that (3) there is no suggestion to modify Riordan to include rating information with a reasonable expectation of success (App. Br. 6). We disagree with the Appellant. As noted *supra*, the Examiner found that a person with ordinary skill in the art would have been motivated to modify Riordan to include the old and well-known feature to store IP rating information in order to reduce the time to make intellectual property purchasing decisions and to reduce due diligence expenses (Ans. 5).

The Appellant has failed to counter the Examiner'a prima facie case by providing any rationale as to why a person with ordinary skill in the art would not have been motivated to reduce the time and expenses related to the trading and selling of intellectual property. The Appellant has further failed to provide any rationale as to why a person with ordinary skill in the art would not have had a reasonable expectation of success when combing a feature to store rating information with Riordan. As such, the Appellant's argument that there is no suggestion to modify Riordan to include rating information with a reasonable expectation of success is not found persuasive.

The Appellant further contends that (4) Riordan fails to describe claims 16-34 (App. Br. 6-8). We disagree with the Appellant. The Examiner found that Riordan describes the limitations of claims 16-20 (Ans. 6). The Appellant has only made conclusory statements that Riordan fails to describe these limitations without providing any rationale as to how the Examiner's erred or any rationale as to how the claimed invention is distinguished from the prior art. As such, the Appellant's arguments in support of claims 16-20 are not found persuasive.

With respect to claims 21-34, the Examiner found that the limitations recited in claims 21-34 are old and well-known in the art and took official notice of these facts (Ans. 6). The Appellant again has failed to seasonably challenge this taking of official notice. Therefore, the Examiner's officially noticed facts are taken to be admitted prior art. As such, the Appellant's argument in support of claims 21-34 is not found persuasive.

The Examiner did not err in rejecting claims 1 and 16-34 under 35 U.S.C. § 103(a) as unpatentable over Riordan and Official Notice.

CONCLUSIONS OF LAW

The Examiner erred in rejecting claims 1 and 16-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner erred in rejecting claims 1 and 16-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention.

The Examiner did not err in rejecting claims 1 and 16-34 under 35 U.S.C. § 103(a) as unpatentable over Riordan and Official Notice.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1 and 16-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is not sustained.
- The rejection of claims 1 and 16-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention is not sustained.
- The rejection of claims 1 and 16-34 under 35 U.S.C. § 103(a) as unpatentable over Riordan and Official Notice is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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